

**BEST AVAILABLE COPY**



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

MU

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/096, 593 06/12/98 O'CONNOR

S A-64559-3/RT

HM22/1004

EXAMINER

RICHARD F TRECARTIN  
FLEHR HOHBACH TEST ALBRITTON AND HERBERT  
FOUR EMBARCADERO CENTER  
SUITE 3400  
SAN FRANCISCO CA 94111-4187

COOK, L

ART UNIT	PAPER NUMBER
----------	--------------

1641

6

DATE MAILED:

10/04/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Art Unit: 1641

**DETAILED ACTION**

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3, drawn to a kit utilized in immunoassay testing, classified in class 435, subclass 7.1.
  - II. Claims 4-15, 25, and 26, drawn to a first container comprising a film covering, classified 436, subclass 518.
  - III. Claims 16-24, drawn to a second container employing electrical contacts and resistors, classified 422, subclass 50.
  
2. The inventions are distinct, each from the other because of the following reasons:  
Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group II (first container) has separate utility such as a packaging material containing food for retail sales. The invention of Group III can be employed in a science experiment to demonstrate how different fluids alter current flow therein. See MPEP § 806.05(d).

Art Unit: 1641

metal ligand- complex is practiced as a probe or sensor that is coated on a device and utilized in cell diagnosis (function) - disease. (See Kolodner et al. 4,819,658 or Schaeffer et al. 4,735,907 ).

Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus of Group III can be used to modulate current by controlling the environment in the chamber surrounding the first electrode.

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the composition of Group I does not have limited utility to only the method in Group II. The composition could be used in detection or as an immunogen.

3. Because these inventions are distinct for the reasons given above and have acquired separate status in the art as shown by their different classification, recognized divergent subject matter and because the search required for each invention is not substantially coextensive with the search required for the remaining invention, restriction for examination purposes as indicated

Art Unit: 1641

is proper. Please note that the classifications in the restriction are illustrative only and do **not** represent all the classes and subclasses which must be searched for each invention; nor is the search limited to issued US patents, but rather includes published foreign patents and applications as well as literature search. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant is invited to submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

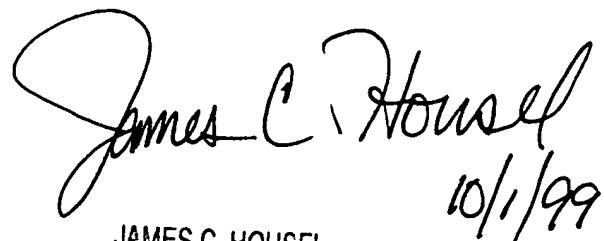
Art Unit: 1641

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 1641 Fax number is (703) 308-4242 which is able to receive transmissions 24 hours/day, 7 days/week.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa V. Cook whose telephone number is (703) 305-0808. The examiner can normally be reached on Monday-Friday from 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
JAMES C. HOUSEL  
SUPERVISORY PATENT EXAMINER  
10/1/99



Lisa V. Cook

October 1, 1999